

With respect to the rejection of Claims 1-7 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over *Petkovsek* in view of *Lockhart et al.*, Applicant submits that the remarks and arguments below overcome the rejections by the Patent Office and places the application in condition for allowance. However, Applicant hereby reserves the right to file a Terminal Disclaimer in compliance with 37 CFR §1.321(c) with respect to the rejection of Claims 1-7 under the judicially created doctrine of obviousness-type double patenting over Claims 1 and 4 of *Petkovsek*. Nevertheless, Applicant does not perceive that a Terminal Disclaimer is necessary because the present invention is patentably distinct from the references of record for the reasons set forth below.

Claim 1 requires a first layer having a front side and a back side wherein the front side of the first layer has a plurality of parts. A first part receives a first type of electronically-imaged postage accessed over a global computer network. A second part receives a second type of electronically-imaged postage accessed over a global computer network. The first type of electronically-imaged postage is different from the second type of electronically-imaged postage. Additionally, one of the first type of electronically-imaged postage and the second type of electronically-imaged postage is necessary to effect the delivery of the mailpiece by the special service.

*Petkovsek* teaches a label/form for receiving and displaying of information relating to shipment and handling of an article for delivery by a special service. Further, the Patent Office alleges that *Petkovsek* teaches a form having a first layer made up of a plurality of parts with a front side and a backside, wherein the front side receives indicia, and the backside comprises removable adhesive. Additionally, the form has a second layer having a front side with a non-adhesive layer wherein one of the plurality of parts receives special service mail information, sender information and recipient information and a post card section.

The Patent Office admits that *Petkovsek* does not disclose a first part of the plurality of parts which receives an electronically imaged postage accessed over a global computer network necessary to effect delivery of the mailpiece and a second part of the plurality of parts which receive electronically imaged postage accessed over a global computer network necessary to effect delivery of a mailpiece. The Patent Office alleges *Lockhart et al.* disclose a form having electronically imaged postage imaged over a global computer network, as allegedly evidenced by Figure 8.

Clearly, neither *Petkovsek* nor *Lockhart et al.*, taken singly or in combination, teach or suggest a form for delivery of a mailpiece by a special service having a first part which receives

a first type of electronically-imaged postage accessed over a global computer network and a second part which receives a second type of electronically-imaged postage accessed over a global computer network as required by Claim 1. Further, neither *Petkovsek* nor *Lockhart et al.*, taken singly or in combination, teach or suggest a form for delivery of a mailpiece by a special service having a first type of electronically-imaged postage which is different from the second type of electronically-imaged postage as required by Claim 1. Still further, neither *Petkovsek* nor *Lockhart et al.*, taken singly or in combination, teach or suggest a form for delivery of a mailpiece by a special service wherein one of the first type of electronically-imaged postage and the second type of electronically-imaged postage is necessary to effect the delivery of the mailpiece by the special service as required by Claim 1.

Rather, the form taught by *Petkovsek* merely has a plurality of parts which receive special service mail information, sender information and recipient information. Further, the system in *Lockhart et al.* is a distribution system for generating and delivering mail items which receives a postage marking. Accordingly, a person of ordinary skill in the art would never have been motivated to modify the teachings of *Petkovsek* in combination with *Lockhart et al.* to achieve the present invention.

With respect to the Patent Office allegation that the limitation "wherein the electronically imaged information is necessary to effect the delivery of the mailpiece" does not structurally limit the claim, Applicant submits that electronically imaged information is necessary to effect the delivery of the mailpiece by the special service and, therefore, structurally limits the claim. More specifically, the present invention, as defined by Claim 1, specifically sets forth a form for delivery of a mailpiece by a special service that requires one of a first type of electronically-imaged postage and a second type of electronically-imaged postage which is necessary to effect the delivery of the mailpiece by the special service.

The Patent Office cited references that specifically relate only to a label/form for receiving and displaying of information relating to shipment and handling of an article for delivery by a special service and a generating system for generating and delivering mail items having an electronically imaged postage mark accessed over a global network. Absolutely no teaching or suggestion is provided for label/form and generating system wherein a first electronically-imaged postage and a second type of electronically-imaged postage are provided and are necessary to effect the delivery of a mailpiece by the special service as required by Claim 1. Moreover, a form having one of a first electronically-imaged postage and a second type of

electronically-imaged postage which is necessary to effect the delivery of a mailpiece by the special service is essential to the present invention and structurally limits Claim 1.

An obviousness-type double patenting requires rejection of an application claim when the claimed subject matter is not patentably distinct from the subject matter claimed in a commonly owned patent when the issuance of a second patent would provide unjustified extension of the term of the right to exclude granted by a patent. Eli Lilly & Co. v. Barr Labs., Inc., 251 F.3d 955, 58 USPQ2d 1865 (Fed. Cir. 2001).

A double patenting rejection of the obviousness-type is "analogous to [a failure to meet] the nonobviousness requirement of 35 U.S.C. §103" except that the patent principally underlying the double patenting rejection is not considered prior art. In re Braithwaite, 379 F.2d 594, 154 USPQ (CCPA 1967). Therefore, any analysis employed in an obviousness-type double patenting rejection parallels the guidelines for analysis of a 35 U.S.C. §103 obviousness determination. In re Braat, 937 F.2d 589, 19 USPQ2d 1289 (Fed. Cir. 1991).

If the application at issue is the later filed application or both are filed on the same day, only a one-way determination of obviousness is needed in resolving the issue of double patenting, i.e., whether the invention defined in a claim in the application is an obvious variation of the invention defined in

a claim in the patent. In re Berg, 46 USPQ2d 1226 (Fed. Cir. 1998).

Moreover, neither *Petkovsek* nor *Lockhart et al.*, taken singly or in combination, teach or suggest a form for delivery of a mailpiece by a special service wherein one of a first type of electronically-imaged postage and a second type of electronically-imaged postage which is necessary to effect the delivery of the mailpiece by the special service and further wherein the first type of electronically-imaged postage is different from the second type of electronically-imaged postage. Furthermore, a person of ordinary skill in the art would never have been motivated to combine the teachings of *Petkovsek* with *Lockhart et al.* in the manner suggested by the Patent Office in formulating the rejection under the judicially created doctrine of obviousness-type double patenting.

In view of the foregoing, the rejection under the judicially created doctrine of obviousness-type double patenting is improper in view of the foregoing remarks and should be withdrawn. Notice to that effect is requested.

With respect to the rejections of Claims 1 and 2 under 35 U.S.C. §103(a) as being unpatentable over *Crandall et al.*, Applicant submits that the remarks and arguments below overcome the rejections by the Patent Office and places the application in condition for allowance. The Patent Office alleges that *Crandall*

et al. disclose:

a first layer (21) having a front side (26) and a back side (22) wherein the front side has a plurality of parts (various sections divided by die-cut) which receive indicia; a second layer (25) having a front side (A) with a non-adhesive layer (Col. 5, lines 4-17), wherein the plurality of parts are removably secured (by adhesive 27).

As stated above, Claim 1 requires a form having a first part which receives a first type of electronically-imaged postage accessed over a global computer network and a second part which receives a second type of electronically-imaged postage accessed over a global computer network. By admission of the Patent Office, *Crandall et al.* do not disclose the plurality of parts which receive electronically imaged postage accessed over a global network wherein the electronically imaged information is necessary to effect the delivery of the mailpiece. Accordingly, a person of ordinary skill in the art would not have been motivated to modify *Crandall et al.* to achieve the present invention.

Further, the Patent Office alleges that Claim 1 is unpatentable for allegedly having an insufficient functional relationship between indicia and substrate. However, Claim 1 requires a form having a first part which receives a first type of electronically-imaged postage accessed over a global computer network and a second part which receives a second type of electronically-imaged postage accessed over a global computer network. The first type of electronically-imaged postage is

different from the second type of electronically-imaged postage. Applicant submits that receiving a first type of electronically-imaged postage in a first part of the form or receiving a second type of electronically-imaged postage in a second part of the form is functionally related to the substrate. As specifically required by Claim 1, the first type and the second type of electronically-imaged postage which are received by the first part and the second part of the form, respectively, are functionally related to the form because one of the first type of electronically-imaged postage and the second type of electronically-imaged postage is necessary to effect the delivery of the mailpiece by the special service. Accordingly, Applicant asserts that Claim 1 provides a functional relationship between indicia and substrate.

Moreover, a person of ordinary skill in the art would never have been motivated to modify the teaching of *Crandall et al.* in the manner suggested by the Patent Office in formulating the rejection under 35 U.S.C. §103(a).

It is submitted that the question under §103 is whether the totality of the art would collectively suggest the claimed invention to one of ordinary skill in this art. In re Simon, 461 F.2d 1387, 174 USPQ 114 (CCPA 1972).

That elements, even distinguishing elements, are disclosed in the art is alone insufficient. It is common to find elements somewhere in the art. Moreover, most if not all elements perform



their ordained and expected functions. The test is whether the invention as a whole, in light of the teachings of the reference in its entirety, would have been obvious to one of ordinary skill in the art at the time the invention was made. Connell v. Sears, Roebuck & Co., 722 F.2d 1542, 220 USPQ 193 (Fed. Cir. 1983).

It is insufficient that the art disclosed components of Applicant's invention. A teaching, suggestion, or incentive must exist to make the combination made by Applicant. Interconnect Planning Corp. v. Feil, 774 F.2d 1132, 1143, 227 USPQ 543, 551 (Fed. Cir. 1988).

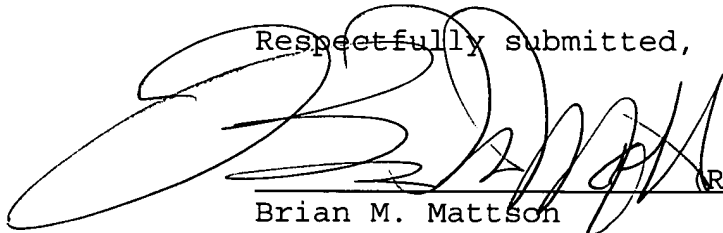
Even assuming that one having ordinary skill in the art could somehow have modified the *Crandall et al.* as set forth by the Patent Office, the resultant modification still lack the critical features and structural relationships positively recited in Claims 1 and 2. Accordingly, the rejection under 35 U.S.C. §103(a) is improper and should be withdrawn. Notice to that effect is requested.

Claims 2-7 depend from Claim 1. These claims are also believed allowable over the references of record for the same reasons set forth with respect to their parent claim since each sets forth additional structural elements of Applicant's form for delivery of a mailpiece by a special service. Notice to that effect is requested.

In view of the foregoing remarks, Applicant respectfully submits that all of the claims in the application are in allowable

form and respectfully solicits allowance of the same. If, however, any outstanding issues remain, Applicant urges the Patent Office to telephone Applicant's attorney so that the same may be resolved and the application expedited to issue. Applicant requests the Patent Office to indicate all claims as allowable and to pass the application to issue.

Respectfully submitted,

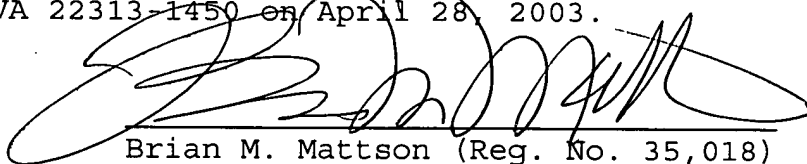


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**CERTIFICATE OF MAILING**

I hereby certify that this **Amendment** is being deposited with the United States Postal Service as First Class Mail in an envelope addressed to: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on April 28, 2003.



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